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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,786	09/07/2004	Ryuichi Hori	2004-1358A	4649

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WENDEROTH, LIND & PONACK, L.L.P.  
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WASHINGTON, DC 20006-1021

EXAMINER
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WENDMAGEGN, GIRUMSEW

ART UNIT	PAPER NUMBER
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2621

MAIL DATE	DELIVERY MODE
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02/25/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/506,786

Applicant(s)

HORI ET AL.

Examiner

Girumsew Wendmagegn

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-27 is/are rejected.
- 7) ☒ Claim(s) 8-10 and 28-30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/7/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 11-20** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 11 is drawn to a "program" *per se* as recited in the preamble and as such is non-statutory subject matter. See MPEP § 2106.IV.B.1.a. Data structures not claimed as embodied in computer readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define

any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

Claim 12-20 also rejected because of the dependency on rejected claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claim 1-7, 11-17 and 21-27** are rejected under 35 U.S.C. 102(b) as being anticipated by Kondo (Pub No US 2002/0051408).

Regarding claim 1, 11, 21, Kondo anticipates a recording apparatus that writes a video stream to a recording medium and edits the video stream, the recording apparatus comprising: an editing unit operable to specify, in accordance with a user operation, a plurality of parts of the video stream as playback sections (see page 3 paragraph 0046, figure 4; page 7 paragraph 0103, figure 8); a display unit operable to display to the user, a plurality of parts that remain after the playback sections are subtracted from the video stream, as non-referenced parts; and a deletion unit operable to delete at least one of the displayed non-referenced parts from the recording medium,

according to a user operation (see page1 paragraph 0004; page3 paragraph0046, figure4 and 5; page7 paragraph 0103, figure 8).

Regarding claim2,12,22, Kondo anticipates the recording apparatus of Claim1, wherein each of the playback sections is represented by a set of starting/ending positions of a playback operation, and the plurality of non-referenced parts include a part from a front-end of the video stream to immediately before a starting position of one of the playback sections that appears first, and a part from immediately after an ending position of one of the playback sections that appears last to a rear-end of the video stream (see page5 paragraph 0056-0058; figure8 , page7 paragraph 0103).

Regarding claim3, 13, 23, Kondo anticipates the recording apparatus of Claim 2, wherein the non-referenced parts include every part immediately after one of the playback sections immediately before another of the playback sections that follows (see figure12 and page7 paragraph 0103).

Regarding claim4, 14, 24, Kondo anticipates the recording apparatus of Claim1, wherein the display performed by the display unit is one of: sequential playback of a plurality of pieces of picture data included in the non-referenced parts; and disposing, on a screen, of a plurality of thumbnails each corresponding to the pieces of picture data (see figure5 and page4 paragraph 0050).

Regarding claim 5, 15, 25, Kondo anticipates the recording apparatus of Claim 1, wherein a plurality of video streams are written to the recording medium, each stream being classified into two or more contents, and the deletion unit deletes only non-referenced parts included in a certain content (see figure 7 page 7 paragraph 0103).

Regarding claim 6, 16, 26, Kondo anticipates the recording apparatus of Claim 5, further comprising: a list-display unit operable to display a list of the contents in the recording medium (see figure 5); and a reception unit operable to receive, from the user, specification of the certain content whose non-referenced parts are to be deleted, wherein the non-referenced parts deleted by the deletion unit are included in the certain content whose specification has been received by the reception unit (see page 7 paragraph 0105).

Regarding claim 7, 17, 27, Kondo anticipates the recording apparatus of Claim 6, wherein a number of contents whose specification is to be received by the reception unit is two or more (see page 7 paragraph 0104).

***Allowable Subject Matter***

**Claim 8-10 and 28-30** objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Girumsew Wendmagegn whose telephone number is 571-270-1118. The examiner can normally be reached on 7:30-5:00, M-F, alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thai Tran  
Supervisory Patent Examiner  
TECHNOLOGY CENTER 2600

Girumsew Wendmagegn